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OCT 12 2005

PATENT APPLICATION
Docket No. 2705-096

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:	Richard FOLTAK and Edward GROENDAAL		
Serial No.:	09/587,164	Group No.:	2642
Filed:	June 2, 2000	Examiner:	AGDEPPA, Hector
Confirmation No.	7344		
For:	CONFIGURABLE DIGIT COLLECTION FOR VARIOUS SIGNALING PROTOCOLS		

TRANSMITTAL LETTER

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Enclosed for filing in the above-referenced application are the following:

☒ Notice of Appeal (Filing Fee $500)
☒ Pre-Appeal Brief Request for Review
☒ Argument in Support of Pre-Appeal Conference
☒ PTO Form 2038 authorizing credit card payment for the above-listed fees
☒ Any deficiency or overpayment should be charged or credited to deposit account number 13-1703.

Customer No. 20575

Respectfully submitted,

MARGER JOHNSON & McCOLLOM, P.C.

Ariel S. Rogson
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I hereby certify that this correspondence is being transmitted to the U.S. Patent and Trademark Office via facsimile number 571-273-8300, on October 12, 2005.

Christina Lawton

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Alexandria, VA 22313-1450

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a Notice of Appeal.

This review is requested for the reason(s) states on the attached sheet(s). Note: no more than five (5) pages may be provided.

I am the:

- ☐ applicant/inventor
- ☐ assignee of record of the entire interest
  See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed)
- ☒ attorney or agent of record
- ☐ attorney or agent acting under 37 CFR 1.34

Total of ONE (1) forms are submitted.

Respectfully submitted,
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PATENT APPLICATION
Docket No. 2705-96
Client Ref. No. Seq. 1695

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:	Richard FOLTAK and Edward GROENENDAAL		
Serial No.	09/587,164	Examiner:	AGDEPPA, Hector
Confirmation No.	7344		
Filed:	June 2, 2000	Group Art Unit:	2642
For:	CONFIGURABLE DIGIT COLLECTION FOR VARIOUS SIGNALING PROTOCOLS		

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ARGUMENTS IN SUPPORT OF PRE-APPEAL BRIEF CONFERENCE

Breidenstein and Mergard are not analogous art

The Federal Circuit has stated that there are two situations in which prior art is considered analogous: first, when the art is in the same field of endeavor as the application; and second, if the reference is reasonably pertinent to the problem the application addresses. *See In re Clay*, 23 U.S.P.Q.2d. 1058 (Fed. Cir. 1992), cited in *Wang Laboratories Inc. v. Toshiba Corp.*, 26 U.S.P.Q.2d 1767, 1773 (Fed. Cir. 1993), and *State Contracting & Engineering Corp. v. Condotte America Inc.*, 68 U.S.P.Q.2d 1481, 1489 (Fed. Cir. 2003). In *Wang Laboratories*, the application related to single in-line memory modules (SIMMs) for use in personal computers; the prior art related to a SIMM for an industrial controller. Despite the fact that the application and the prior art both related to memory, this was not enough for the prior art to be considered in the same field of endeavor as the application.

Similarly, the claims in the application and Mergard are not in the same field of endeavor. The claims are directed toward using programmable state machines in telephone circuits, but Mergard teaches programmable state machines in silicon. As Mergard states in the field of the invention (column 1, lines 5-7), Mergard relates to hardware state machines for microcontrollers, not for telephone circuits. In addition, as described in the specification, templates use signaling templates using entries from Table 1. But Mergard uses masks comprising bits (as described at column 5, line 47 through column 6, line 22). Thus, the masks of Mergard are not even the same thing as the template of the invention. As Breidenstein and Mergard are non-analogous art, the Examiner cannot combine them in arguing that the invention is obvious.

The Examiner admits that elements, such as "computers, semiconductors, processors, controllers, databases, etc. are all in arts separate from the telephony arts. Yet, as is well know, all these elements and devices and software can and are very frequently used in telephony systems . . . ." While this may be true, that does not mean that a person skilled in the art of telephony systems would bother to examine every possible teaching in these other arts. The claimed invention relates to a network processing device; a person skilled in this art, even if he or she were completely aware that the device utilized processors, controllers, etc., would not necessarily look to how processors are programmed in fields outside the telephony arts. Thus, Breidenstein and Mergard are not analogous art.

There is no motivation to combine Breidenstein with Mergard, Andruska, or Hayball

In arguing that there is a motivation to combine Breidenstein with Mergard, the Examiner states that "[t]he motivation for this [combination] is simply that less protocol/signaling prediction is needed when dynamic configuration is available" (Office Action dated July 14, 2005, page 3). This statement is conclusory, indicating what the Examiner would expect if Breidenstein were modified in a particular way. Further, the Examiner is using hindsight in his analysis, in that he is using the invention as claimed to suggest pieces that he is using in combination to reject the claims. But a proper obviousness rejection requires the Examiner to "ascertain what would have been obvious to one of ordinary skill in the art at the time the invention was made" (MPEP 2141.03). In other words, the combination must have been obvious to someone who knows nothing about the invention.

The Examiner continues by saying that "[t]he technology taught by Breidenstein et al. is merely older and it would again be obvious to update it with the more flexible dynamically programmable aspect taught by Mergard" (Office Action dated July 14, 2005, page 3). In admitting that Breidenstein is older than Mergard, the Examiner has basically stated that the motivation to combine the references cannot come from Breidenstein. But the Examiner nevertheless is arguing that the combination would be obvious based on the teaching of Breidenstein. This also shows that the Examiner is arguing from hindsight.

In arguing that there is motivation to combine Breidenstein with Andruska, the Examiner states that "[i]t is a design choice or preference to keep an old template or basic data template an[d] merely override it with a new one as needed because on one sense, no system resources are used or wasted deleting templates or data to only later-recreate them. Therefore it would have been obvious to implement the overriding template feature of Andruska et al. in the systems of Breidenstein et al. and Mergard" (Office Action dated July 14, 2005, page 4). The fact that deleting or overriding an existing template might be a "design choice" does not mean that there is motivation to make the combination. This is stated in MPEP § 2143.01, which states that "the mere fact that references <u>can</u> be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination" (emphasis in original). To meet the burden of a prima

facie case for obviousness, the Examiner needs to show a motivation to combine; the Examiner's statement that deleting or overriding an existing template is a "design choice" does not show a motivation to combine.

In arguing that it would be obvious to combine Hayball with Breidenstein, the Examiner argued that "it would have been obvious for one of ordinary skill in the art at the time the invention was made to have increased capacity in Breidenstein et al. by merely adding another trunk controller or equivalent thereof" (Office Action dated July 14, 2005, page 5). Increasing the capacity of Breidenstein might be nice, but that does not show that a person skilled in the art would be motivated to combine Breidenstein and Hayball: that is, that there is any reason to combine Breidenstein and Hayball.

None of the references teach or suggest a single apparatus supporting multiple signaling templates

The Examiner acknowledged on page 3 of the Office Action dated January 16, 2004, that Breidenstein does not teach the use of dynamically configurable signaling templates. Mergard teaches only a single state machine that can be programmed: that is, the state machine of Mergard can only be programmed with one state machine at a time. To support multiple templates simultaneously would require reprogramming the state machines at each step, a concept not taught or suggested by Mergard. (The Applicant also notes that Mergard does *not* teach a meta-state machine: that is, a machine that would receive two inputs: the signals and the template. And even if Mergard taught such a concept, the programmable state machine of Mergard could only simulate one state machine at a time.) Thus, neither Breidenstein nor Mergard teaches the concept of a single device supporting multiple templates.

The Examiner cites to Andruska for the concept of a device that can store multiple templates. However, Andruska only teaches storing a default position in static data block 9, which can be preempted by data in dialable static data items 11. In other words, Andruska is not teaching two templates that can be used in parallel; if the data in the dialable static data items 11 are being used, then the data in the static data block 9 are not being used. Thus, Andruska does not introduce the concept of a single device that can support multiple templates simultaneously.

The Examiner alternatively argues that Hayball teaches the use of multiple trunk controllers. But trunks are distinguishable from the signaling that occurs over the trunk; the trunk controller of Hayball does not mean that Hayball teaches being able to manage multiple signaling templates.

The Examiner goes on to states that "there is no different operation or functionality being claimed by adding a second controller" (Office Action dated July 14, 2005, page 5). The Applicant is unclear what the Examiner refers to as "being claimed". The Applicant is not claiming multiple controllers; the claimed invention is directed toward a single device and a method to operate that

device that can control signaling over multiple trunk controllers, where each line is using a different signaling template. The Applicant asserts that none of the references teach this feature.

Andruska specifically teaches away from the Examiner's proposed combination

At column 3, lines 13-15, Andruska describes how the Andruska invention could operate. Andruska says that "most of the items in static data block 9 are administered by an operating telephone company and cannot be modified by callers". Signaling is certainly a feature that is administered by a telephone company and should not be modified by callers. Thus, Andruska specifically teaches away from its operation in conjunction with signaling. But as this is exactly what the Examiner is arguing, the Examiner is arguing against the plain teaching of Andruska.

None of the references teach an apparatus capable of supporting multiple state machines

In the telephone interview held on August 16, 2004, the Examiner acknowledged that neither Breidenstein nor Mergard taught the concept of a device that allowed adding a new signaling template without deleting an existing template. The Examiner argued that Andruska taught this feature. But this is not what Andruska teaches. Andruska teaches the ability to retain a default template when a customer selects feature keys. As indicated in Andruska, one way the system works is "by creation of a shadow static data block and controller in memory 40 which sits on top of the call process 32 to allocate and manage the telephone network hardware and software as though the shadow static data block were the actual static data block 9 for terminal port 3 by preempting, in whole or in part, the telephone network's system reference to the actual data block 9 and the resident feature key configuration" (Andruska, column 4, lines 16-26). Note the use of the word "preempting": in other words, only 1 block can be active at any time. Thus, while Andruska might not actually delete the default programming when a customer selects features, the default is no longer available for use. Thus, Andruska does not teach adding a new signaling template that can be used in parallel with the earlier template, as claimed.

In responding to the Applicant's arguments, the Examiner misunderstood the previous arguments

In responding to the Applicant's earlier arguments, the Examiner stated that "none of the claims use language that suggest that anything happens simultaneously" (Office Action dated July 14, 2005, page 8). This is not what had been argued. The Applicant had argued that Breidenstein and Mergard did not teach or suggest "a device capable of supporting multiple state machines simultaneously" (Response to Office Action dated December 2, 2004, page 15). The Examiner is asked to note the use of the word "capable". The device could support multiple state machines at the same time. This did not mean that the multiple state machines were all operating at the same time (although they could).

The Examiner also stated that "applicant's arguments that the claimed invention does not set any limits on the number of signaling templates is not a limitation that is actually claimed". The Applicant respectfully disagrees. The claims, admittedly, do not explicitly state that there is no limit to the number of templates. But claim 1, for example, describes "a memory for storing a dynamically configurable set of signaling templates". First, the claim includes the word "set", which is not necessarily limited to one member; second, the plural word "templates" is used, which suggests more than one template without limiting the actual number. Intuitively, the number of templates is clearly a function of the size of the memory: increase the memory and the number of templates that can be stored can increase. Thus, there is no limit set on the number of templates stored in the memory. In contrast, Breidenstein and Mergard are each limited to describing handling one programming, and even if Andruska could be read as describing two programmings (which the Applicant disputes), Andruska does not teach or suggest the possibility of more than two programmings.

The Applicant also asserts all arguments made previously, whether or not explicitly discussed herein, to preserve the right to assert these arguments in the Appeal Brief.

Respectfully submitted,

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